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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

POND, ROBERT M

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 09/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/533,212

Applicant(s)

MCINTYRE, DALE F. 

Examiner

Robert M. Pond

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 18, and 20-22 is/are rejected.
- 7) ☒ Claim(s) 10, 11 and 14-19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Drawings

1. This application has been filed with informal drawings, which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Specification

2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Objections

3. Claim 14 is objected to because of the following informalities: "of" missing in line 2 between "images" and "said." Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements,

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such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The scope of Claim 1 is unclear. Applicant is attempting to limit a system claim with a method step (1c) and is claiming a list of disassociated parts. Appropriate correction is required to put into proper form.

5. Claims 3-5 and 8-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
- Claim 3: “printing” introduces method claim language into structural element that comprises the image order. Appropriate action is necessary to put system claim language into proper form.
 - Claim 4: “scanning” introduces method claim language into structural element that comprises the image order. Appropriate action is necessary to put system claim language into proper form.
 - Claim 5: “are provided” introduces method claim language into structural element that comprises the hard copy images. Appropriate action is necessary to put system claim language into proper form.
 - Claim 8: “scanning” introduces method claim language into structural element that comprises the image order. Appropriate action is necessary to put system claim language into proper form.

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- Claim 9: "crediting" introduces method claim language into structural element that comprises the predetermined criteria. Appropriate action is necessary to put system claim language into proper form.
 - Claim 10: "are compared" introduces method claim language into structural element. Appropriate action is necessary to put system claim language into proper form.
 - Claim 11: "that is provided to said customer upon reaching said threshold value" introduces method claim language into system claim that should further limit "threshold value." Appropriate action is necessary to put system claim language into proper form.
6. Claim 10 recites the limitation "number of unprintable images" in line 2. There is insufficient antecedent basis for this limitation in the claim. For examination purposes, Claim 10 has been interpreted as having depended from Claim 9. Applicant must make appropriate corrections.
7. Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This examiner assumes applicant is referring to a) "said roll of film" as "said roll of photographic film" of Claim 17, and b) "unprintable images" as "accrued unprintable images," for examination purposes.

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8. Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: further limiting Claim 17 with method claim language comparing numbers to determine equality.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-9, 12, 13, and 20-22 are rejected under 35 USC 103(a) as being unpatentable over Shiota et al, patent number 6,324,521.

Shiota et al teaches a system and method of Fuji Photo Film Company of providing customers with a photographic service via a computer network. Shiota et al teaches a fulfillment center managing one or more orders, routing photo processing jobs to minilabs and special laboratories, processing and delivering automatically to the customer a first set of prints, and customers connecting remotely to the service via the Internet for viewing, ordering extra prints or other products and services, and sharing photos with friends (see at least abstract; Fig. 1 (1, 2, 3, 4, 5); Fig. 6 (36); Fig. 7 (6); col. 1, lines 54-67; col. 2, lines 1-9; col. 2, lines 56-67; col. 7, lines 58-62). Shiota et al teaches image retaining devices comprising one or more rolls of photographic film, creating a first set of prints and then electronically scanning and converting into digital images for online viewing (see at least Fig. 1 (7); col. 2, lines 33-41), storing digital images in databases (see at least Fig. 6 (33, 34, 38, 40); col. 10, lines 65-67; col. 11, lines 1-12), and

automatically providing a product after reaching a predetermined criteria (col. 9, lines 40-52, col. 10, lines 4-29). Registration information for an order comprises a reception number unique to the order, a processing number unique to the service requested for the images being supplied, and a plurality of image numbers or image identification (ID) numbers, each being unique to the associated digital image (see at least Fig. 2; col. 3, lines 31-35). Shiota et al teaches the use of a web browser plug-in to facilitate browsing and image viewing, and processing application software to manipulate images prior to ordering goods or service. Shiota et al teaches services and goods such as outputting prints, extra prints, picture postcard, and compact disc (CD) (see at least Fig. 6 (11); col. 10, lines 54-58), generating pass codes for online access, and arrangements or images in an album (see at least col. 4, lines 28-42). Shiota et al further teaches ordering information comprising one or more formats (see at least Figs. 2; col. 6, lines 46), of which the format in Fig. 2 discloses a unique reception number that is used as a registration number for an image retaining device, each image retaining device number comprising at least one image identified by an image number. Shiota et al further discloses an hierarchical approach to order information processing (see at least Fig. 3; col. 6, line 47) whereby in Fig. 3 Order Information 1 represents ordering information for the first image retaining device, Order Information 2 represents the ordering information of the second image retaining device, and etc., whereby the print order file comprises a group or subgroups associated with a print order.

Shiota et al teaches all the above as noted under the 103(a) rejection and further teaches customer charge control or customer electronic settlement, but does not disclose automatically assigning credit on behalf of a customer based on predetermined criteria and a plurality of image orders. It is an old and well known business practice for customer charge control or settlement systems to accommodate credits applied to a customer's account for one or more orders to encourage future business or keep a current customer satisfied with a convenient settlement process. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Shiota et al to include crediting customer accounts, in order to provide additional convenience to the customer.

Shiota et al teaches all the above as noted under the 103(a) rejection and further teaches obtaining a picture image by a laboratory with a film scanner by scanning photographic film received by a customer, but does not disclose predetermined criteria for crediting the customer. It is an old and well-known practice within the photofinishing industry to not charge for frames on a roll that are not printed. An example of frames that are not printed would be blank frames or unused frames. Pre-paid film mailers deal with this problem by crediting the customer in the form of a credit slip and therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Shiota et al to include predetermined criteria comprising a number of blank frames, in order to credit the customer for unprinted images.

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cancelled

Allowable Subject Matter

12. Claims 10 (as interpreted), 11, and 14-19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- US 5,692,834 (PAGANO) 02 December 1997; teaches prior art of pre-paid photographic film mailers and customers receiving credit for images not printed.
- Supermarket News, "Kroger Deals Out Frequent Photo Card," 15 April 1996, p51, Dialog file 16 #04301832; teaches film processing and customers receiving free film for pre-determined criteria of having 9 rolls of film processed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mr. Robert M. Pond** whose telephone number is 703-605-4253. The examiner can normally be reached Monday-Friday, 8:30AM-5:30PM EDT.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Ms. Wynn Coggins** can be reached on 703-308-1344.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **703-308-1113**.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks


Washington D.C. 20231

or faxed to:

703-305-7687 (Official communications; including After Final communications labeled "Box AF")

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

RMP
September 16, 2002


JEFFREY A. SMITH
PRIMARY EXAMINER